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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/505,288  | 04/14/2005  | Bogdan Rosinski      | 003D.0026.U1(US)            | 5178             |
| 29683   | 7590        | 12/27/2005           | EXAMINER                    |                  |
| HARRINGTON & SMITH, LLP<br>4 RESEARCH DRIVE<br>SHELTON, CT 06484-6212 |             |                      | CONNELLY CUSHWA, MICHELLE R |                  |
|   |             |                      | ART UNIT                    | PAPER NUMBER     |
|   |             |                      | 2874                        |                  |
| DATE MAILED: 12/27/2005   |             |                      |                             |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

EJK

|                              |  |   |  |
|------------------------------|--|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/505,288           | <b>Applicant(s)</b><br>ROSINSKI, BOGDAN |  |
|                              | <b>Examiner</b><br>Michelle R. Connelly-Cushwa | <b>Art Unit</b><br>2874                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/19/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The prior art documents submitted by applicant in the Information Disclosure Statement filed on August 19, 2004 have all been considered and made of record (note the attached copy of form PTO-1449).

### ***Drawings***

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

It is noted that, beginning page 4 and continuing throughout the remainder of the present application, reference is made to Figures 1a, 1b, 2a and 2b. However, no drawing sheets have been filed in the present application. For the purposes of examination, the Examiner has referred to Figures 1a, 1b, 2a and 2b of the foreign priority document (France 0202248) filed August 19, 2004 to which the present application claims priority from.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claim 1; the claim recites the limitation "intermediate integrated circuit" in lines 7-8 of the claim. It appears from the Figures of the parent application that the "intermediate integrated circuit" is labeled with reference number 21. However, it is not clear from either the claim language or the Figures, which the circuit is intermediate to.

Regarding claim 9, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Aihara (US 6,491,447 B2).**

Regarding claim 1; Aihara discloses an optoelectronic coupling device (see Figures 2B, 4, 6A, 6B, 8A and 8B), the device comprising a package (31) provided with an optical port to receiver terminations of an optical fibers (15; Figure 6A illustrates multiple fibers), a mirror (34) in a cavity to reflect light rays coming from or intended for the optical fibers (15) and an optoelectronic circuit (37) to convert the light rays into electrical signals or vice versa, characterized by the fact that the package is made of plastic (see the abstract) and that the mirror is capable of focusing at a finite distance (see Figures 2B and 4) and that the optoelectronic circuit (37) is mounted on the package with solder (see column 3, lines 50-56) and comprises an intermediate integrated circuit (35) surmounted to the optoelectronic circuit (37) with solder, wherein the optoelectronic circuit (37) forms a detection and/or transmission circuit that is spaced at the pitch of the optical fibers, which are spaced at the pitch of alignment grooves (52), which may optionally be present to easily align the fibers (see the entire disclosure, especially column 6, lines 44-55; column 7, lines 44-51; and column 8, lines 41-63).

Applicant is claiming the product including the process of mounting the optoelectronic circuit and intermediate integrated circuit, and therefor are of "product-by-process" nature. The courts have been holding for quite some time that: the determination of the patentability of product-by-process claim is based on the product itself rather than on the process by which the product is made. In re Thrope, 777 F. 2d

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695, 227 USPQ 964 (Fed. Cir. 1985); and patentability of claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. Applicant has chosen to claim the invention in the product form. Thus a prior art product which possesses the claimed product characteristics can anticipate or render obvious the claim subject matter regardless of the manner in which it is fabricated. A rejection based on 35 U.S.C. section 102 or alternatively on 35 U.S.C. section 103 of the status is eminently fair and acceptable. In re Brown and Saffer, 173 USPQ 685 and 688; In re Pilkington, 162 USPQ 147. As such no weight is given to the process steps recited in claim 1.

Regarding claim 3; the facet of the mirror (34) may be parabolic (see Figures 2B and 4).

Regarding claim 4; the mirror (34) may be metallized (see column 4, lines 34-36).

Regarding claim 5; the package comprises metallized tracks (36).

Regarding claim 6; the package may optically comprise V-grooves (52).

Regarding claim 7; the curvature of the mirror is inherently adapted to single-mode or multimode character of light signals, as there are no other options, and the optical fibers must inherently transmit or receive single-mode or multimode light.

Regarding claim 8; the mirror (34) is concave curved.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aihara (US 6,491,447 B2).**

Regarding claim 2; Aihara discloses all of the limitations of claim 2 as applied above, except for the device further comprising sections of intermediate optical fibers. One of ordinary skill in the art would have found it obvious to incorporate intermediate sections of optical fibers in the invention of Aihara in order to extend the length of the optical path beyond the length of a single piece of fiber as desired.

Regarding claim 9; Aihara discloses all of the limitations of claim 9 as applied above, except for specifically stating that the plastic material is a high-temperature plastic material. However, one of ordinary skill in the art would have found it obvious to form the package from a high-temperature plastic material that would not be easily deformed or compromised in the presence of heat to avoid misalignment of the optical elements that would result from such deformation and the corresponding optical loss, since optical-electrical packages are commonly used in equipment that produces a large amount of heat.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kragl (US 6,813,418) discloses an optoelectronic package (see Figures 1 and 2); Kuo et al. (US 5,369,529) discloses an optoelectronic package (see Figure 1); and Gruenwald et al. (US 5,987,202) discloses an optoelectronic package (see Figure 7).

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Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (571) 272-2345. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (571) 272-1562.

*Michelle R. Connelly-Cushwa*  
Michelle R. Connelly-Cushwa  
Patent Examiner  
December 22, 2005